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SCHWABE, WILLIAMSON & WYATT, P.C. PACWEST CENTER, SUITES 1600-1900 1211 SW FIFTH AVENUE PORTLAND, OR 97204			SALAD, ABDULLAHI ELM I	
			ART UNIT	PAPER NUMBER
			2157	

DATE MAILED: 03/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/781,129	Applicant(s) ZEHR ET AL.	
	Examiner Salad E Abdullahi	Art Unit 2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. This application has been reviewed. Original claims 1-40 are pending. The rejection cited stated below.
2. The amendment filed on 10/21/2004 has been received and made of record.
3. Applicant's argument with respect to claims 1-40 have been considered but are moot in view of new ground of rejection.

Furthermore, Ryan (the new reference) provides selectively inserting into a message sent by the user/subscriber to other recipients, at the control/option of the user/subscriber, to reduce the communication cost of the user/subscriber (see col. 11, lines 19-54 and col. 12, lines 17-30).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

Art Unit: 2157

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1, 4-5, 8-12, 15-21, 24-25, 28-32, and 35-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ukita et al., U.S. Patent No. 6,622,174[hereinafter Ukita] in view of Ryan U.S. Patent No. 6,816,838[hereinafter Ryan]

As to claim 1, Ukita discloses method comprising:

receiving an indication to send a message to a plurality of recipients (see col. 4, line 45 to col. 5, line 14);

determining if an insertion of an advertisement of a selected one of a link to an advertisement of an advertiser and the advertisement itself, the advertisement having a monetary value associated with it, is received (see col. 25, lines 13-35 and col. 35, lines 22-29); and

Ukita is silent regarding: receiving the indication to insert advertisement to the message from the sender of the message, and automatically reducing the cost of sending the message to plurality of recipients by the monetary value of the inserted advertisement.

Ryan discloses a method for creating a message intended for plurality of recipients including the step of receiving the indication to insert advertisement to the message from the sender of the message, and automatically reducing the cost of sending the message to plurality of recipients by the monetary value of the inserted advertisement.

(see col. 11, lines 19-54 and col. 12, lines 17-30). Furthermore, Ryan discloses the sender of the mail is allowed to select the advertisement with the highest value to be inserted to the sender's mail to minimize the cost of sending mail to the plurality of

Art Unit: 2157

recipients. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the teaching of Ryan such as enabling the sender of the mail to insert advertisement to the mail into Ukita's system, thus providing an increased economic incentive for sender of the mail as well as the third party advertisers.

As to claim 4, Ukita discloses the method of claim 1, wherein said receiving the indication comprises receiving a group selection (see col. 17, lines 19-33).

As to claim 5, Ryan discloses the method of claim 1, wherein said automatically determining the monetary cost comprises automatically determining a monetary cost based at least in part on a number of the plurality of recipients (i.e., plurality of members) (see col. 11, lines 19-54 and col. 12, lines 17-30).

As to claim 8, Ukita discloses the method of claim 1, wherein said receiving the insertion comprises automatically generating and displaying a selectable menu of a category of advertisers, the category based at least in part on attributes associated with the plurality of recipients (see col. 17, lines 19-25 and col. 35, lines 22-29).

As to claim 9, Ukita discloses the method of claim 1, wherein said receiving the insertion comprises receiving an insertion of a selected one of a link to an advertisement of an advertiser and the advertisement itself (see col. 19, lines 6-34).

Art Unit: 2157

As to claim 10, Ukita discloses the method of claim 1, wherein said receiving the insertion comprises receiving an inputted category of an advertiser (see col. 17, lines 19-25).

As to claim 11, Ukita discloses the method of claim 1, wherein said automatically reducing the monetary cost comprises automatically reducing the monetary costs by a monetary value of one or more inserted advertisements (see col. 11, lines 5-14 and col. 35, lines 22-29).

As to claim 12, Ukita discloses in a client device, a method comprising:
facilitating sending a message to a plurality of recipients (i.e., targeted users) included within a group (i.e., members) (see col. 4, line 45 to col. 5, line 14);
facilitating insertion of a selected one of a link to an advertisement of an advertiser and the advertisement itself, in the message prepared by a sender, the advertisement having a monetary value associated with it (see col. 25, lines 13-35); and
facilitating updating of the monetary cost associated with sending the message(see col. 35, lines 22-29).

Ukita is silent regarding: receiving the indication to insert advertisement to the message from the sender of the message, and automatically reducing the cost of sending the message to plurality of recipients by the monetary value of the inserted advertisement.

Ryan discloses a method for creating a message intended for plurality of recipients including the step receiving from the sender of the message an indication to insert

Art Unit: 2157

advertisement to reduce the cost of sending the message to plurality of recipients and automatically reducing the cost associated with sending the message based of the value of inserted advertisement (see col. 11, lines 19-54 and col. 12, lines 17-30).

Furthermore, Ryan discloses the sender of the mail is allowed to select the advertisement with the highest value to be inserted to the sender's mail to minimize the cost of sending mail to the plurality of recipients. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the teaching of Ryan such as enabling the sender of the mail to insert advertisement to the mail into Ukita's system, thus providing an increased economic incentive for sender of the mail as well as the third party advertisers.

As to claim 15, Ukita discloses the method of claim 12, wherein said sending facilitation comprises facilitating selection of a single group, the group including the plurality of recipients (see col. 17, lines 19-25).

As to claim 16, Ukita discloses the method of claim 12, wherein said sending facilitation comprises facilitation of automatic generation and displaying an e-mail messaging window (see col. 1, lines 59-64).

As to claim 17, Namias discloses the method of claim 12, wherein said receiving facilitation comprises facilitating automatic generation and displaying of the received

Art Unit: 2157

monetary cost included within a cost window (see fig. 6, price display window 620 and page 3, paragraph 0041).

As to claim 18, Ukita discloses the method of claim 12, wherein said insertion facilitation comprises facilitating automatic arrangement of the link to the advertisement/the advertisement itself (see col. 19, lines 6-34).

As per claim 19, Ryan discloses wherein said automatic arrangement facilitation comprises facilitating receiving an associated price for a position and size on a message page, the arrangement based at least in part on the price (see fig. 5c and col. 9, lines 36-67)

As to claim 20, Ukita discloses the method of claim 12, wherein said updating facilitation comprises facilitating receiving a reduced monetary cost, the received reduced monetary cost based at least in part on the value of the inserted link to the advertisement/the advertisement itself (see col. 11, lines 5-14).

As to claim 21, Ukita discloses an apparatus (see fig. 6) comprising:
a storage medium having stored therein a plurality of programming instructions designed to receive an indication to send a message to a plurality of recipients (see col. 4, line 45 to col. 5, line 14), determine if an insertion of an advertisement of a selected one of a link to an advertisement of an advertiser and the advertisement itself, the

Art Unit: 2157

advertisement having a monetary value associated with it, is received (see col. 25, lines 13-35), and automatically reduce the monetary cost associated with sending the message by the value of the inserted link to the advertisement/the advertisement itself, upon determining that the insertion is received(see col. 25, lines 13-35); and a processor coupled to the storage medium to execute the programming instructions (see fig. 6, and col. 12, lines 58-67).

Ukita is silent regarding: receiving the indication to insert advertisement to the message from the sender of the message, and automatically reducing the cost of sending the message to plurality of recipients by the monetary value of the inserted advertisement.

Ryan discloses a method for creating a message intended for plurality of recipients including the step of receiving the indication to insert advertisement to the message from the sender of the message, and automatically reducing the cost of sending the message to plurality of recipients by the monetary value of the inserted advertisement.

(see col. 11, lines 19-54 and col. 12, lines 17-30). Furthermore, Ryan discloses the sender of the mail is allowed to select the advertisement with the highest value to be inserted to the sender's mail to minimize the cost of sending mail to the plurality of recipients. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the teaching of Ryan such as enabling the sender of the mail to insert advertisement to the mail into Ukita's system, thus providing an increased economic incentive for sender of the mail as well as the third party advertisers.

Art Unit: 2157

As to claim 24, Ukita discloses the apparatus of claim 21, wherein the programming instructions are designed to receive a group selection (see col. 17, lines 19-33).

As to claim 25, Ryan discloses the apparatus of claim 21, wherein the programming instructions are designed to automatically determine a monetary cost based at least in part on a number of the plurality of recipients (see fig. 5c and col. 9, lines 36-67)

As to claim 28, Ukita discloses the apparatus of claim 21, wherein the programming instructions are designed to automatically generate and display a selectable menu of a category of advertisers, the category based at least in part on attributes associated with the plurality of recipients (see col. 17, lines 19-25 and col. 35, lines 22-29).

As to claim 29, Ukita discloses the apparatus of claim 21, wherein the programming instructions are designed to receive an insertion of a selected one of a link to an advertisement of an advertiser and the advertisement itself (see col. 11, lines 5-14).

As to claim 30, Ukita discloses the apparatus of claim 21, wherein the programming instructions are designed to receive an inputted category of an advertiser (see col. 17, lines 19-33).

As to claim 31, Ukita discloses the apparatus of claim 21, wherein the programming instructions are designed to automatically reduce the monetary costs by a monetary

value of one or more inserted advertisements (see col. 11, lines 5-14 and col. 35, lines 22-29).

As to claim 32, Ukita discloses an apparatus comprising: a storage medium having stored therein a plurality of programming instructions designed to facilitate sending a message to a plurality of recipients included within a group (see col. 4, line 45 to col. 5, line 14), facilitate insertion of a selected one of a link to an advertisement of an advertiser and the advertisement itself, in the message prepared by a sender (see col. 11, lines 5-14), the advertisement having a monetary value associated with it (see col. 11, lines 5-14), and facilitate updating of the monetary cost associated with sending the message(see fig. 6, and col. 12, lines 58-67); and a processor coupled to the storage medium to execute the programming instructions(see fig. 6, and col. 12, lines 58-67).

Ukita is silent regarding: receiving the indication to insert advertisement to the message from the sender of the message, and automatically reducing the cost of sending the message to plurality of recipients by the monetary value of the inserted advertisement.

Ryan discloses a method for creating a message intended for plurality of recipients including the step of receiving the indication to insert advertisement to the message from the sender of the message, and automatically reducing the cost of sending the message to plurality of recipients by the monetary value of the inserted advertisement.

(see col. 11, lines 19-54 and col. 12, lines 17-30). Furthermore, Ryan discloses the sender of the mail is allowed to select the advertisement with the highest value to be inserted to the sender's mail to minimize the cost of sending mail to the plurality of

Art Unit: 2157

recipients. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the teaching of Ryan such as enabling the sender of the mail to insert advertisement to the mail into Ukita's system, thus providing an increased economic incentive for sender of the mail as well as the third party advertisers.

As to claim 35, Ukita discloses 35 the apparatus of claim 32, wherein the programming instructions are designed to facilitate selection of a single group, the group including the plurality of recipients (see col. 17, lines 19-33).

As to claim 36, Ukita discloses 36 the apparatus of claim 32, wherein the programming instructions are designed to facilitate automatic generation and displaying an e-mail messaging window (see col. 1, lines 59-64).

As to claim 38, Ukita discloses the apparatus of claim 32, wherein the programming instructions are designed to facilitate automatic arrangement of the link to the advertisement/the advertisement itself (see col. 11, lines 5-14 and col. 19, lines 6-34).

As per claim 39, Ryan discloses wherein said automatic arrangement facilitation comprises facilitating receiving an associated price for a position and size on a message page, the arrangement based at least in part on the price (see fig. 5c and col. 9, lines 36-67)

As to claim 40, Ukita discloses the apparatus of claim 32, wherein the programming instructions are designed to facilitate receiving a reduced monetary cost, the received monetary cost based at least upon the value of the inserted link to the advertisement/the advertisement itself (see col. 11, lines 5-14 and col. 19, lines 6-34).

7. Claims 2-3, 13-14, 22-23, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable Ukita and Ryan and further in view of Heiden U.S. Patent No. 6,408,286 [hereinafter Heiden].

As to claim 2, Ukita and Ryan discloses substantial features of the claimed invention as discussed above with respect to claim 1, including attaching advertisement to a messages.

Ukita and Ryan are silent regarding:

automatically attaching one or more coupons to the message, based at least upon the inserted advertisement.

Heiden in analogous art discloses system for distributing digital coupons in including the step of automatically attaching one or more coupons to the message, based at least upon the inserted advertisement (see col. 3, lines 48-67 and col. 5, lines 35-51).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the teaching of Heiden such as automatically attaching one or more coupons to the message, based at least upon the inserted advertisement

Art Unit: 2157

into the system of Ukita and Ryan because the advantage of attaching one or more coupons to the message, is to provide users with incentive to buy more products.

As to claim 3, Heiden discloses the method of claim 2, wherein the attached one or more coupons is at least one of an electronic coupon and a printable coupon (see col. 3, lines 48-67 and col. 5, lines 35-51).

As to claim 13, Ukita and Ryan discloses substantial features of the claimed invention as discussed above with respect to claim 12, including attaching advertisement to a messages.

Ukita and Ryan are silent regarding:

automatically attaching one or more coupons to the message, based at least upon the inserted advertisement.

Heiden in analogous art discloses system for distributing digital coupons in including the step of automatically attaching one or more coupons to the message, based at least upon the inserted advertisement (see col. 3, lines 48-67 and col. 5, lines 35-51).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the teaching of Heiden such as automatically attaching one or more coupons to the message, based at least upon the inserted advertisement into the system of Ukita and Ryan because the advantage of attaching one or more coupons to the message, is to provide users with incentive to buy more products.

Art Unit: 2157

As to claim 14, Heiden discloses the method of claim 12, wherein the attached one or more coupons is at least one of an electronic coupon and a printable coupon (see col. 3, lines 48-67 and col. 5, lines 35-51).

As to claim 22, Ukita and Ryan discloses substantial features of the claimed invention as discussed above with respect to claim 21, including attaching advertisement to a messages.

Ukita and Namias are silent regarding:

automatically attaching one or more coupons to the message, based at least upon the inserted advertisement.

Heiden in analogous art discloses system for distributing digital coupons in including the step of automatically attaching one or more coupons to the message, based at least upon the inserted advertisement (see col. 3, lines 48-67 and col. 5, lines 35-51).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the teaching of Heiden such as automatically attaching one or more coupons to the message, based at least upon the inserted advertisement into the system of Ukita and Ryan because the advantage of attaching one or more coupons to the message, is to provide users with incentive to buy more products.

As to claim 23, Heiden discloses the method of claim 22, wherein the attached one or more coupons is at least one of an electronic coupon and a printable coupon (see col. 3, lines 48-67 and col. 5, lines 35-51).

As to claim 33, Ukita and Ryan discloses substantial features of the claimed invention as discussed above with respect to claim 21, including attaching advertisement to a messages.

Ukita and Ryan are silent regarding:

automatically attaching one or more coupons to the message, based at least upon the inserted advertisement.

Heiden in analogous art discloses system for distributing digital coupons in including the step of automatically attaching one or more coupons to the message, based at least upon the inserted advertisement (see col. 3, lines 48-67 and col. 5, lines 35-51).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the teaching of Heiden such as automatically attaching one or more coupons to the message, based at least upon the inserted advertisement into the system of Ukita and Ryan because the advantage of attaching one or more coupons to the message, is to provide users with incentive to buy more products.

As to claim 34, Heiden discloses the method of claim 33, wherein the attached one or more coupons is at least one of an electronic coupon and a printable coupon (see col. 3, lines 48-67 and col. 5, lines 35-51).

Art Unit: 2157

8. Claims 6-7, 26-27 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ukita and Ryan as applied to claim 1 above, and further in view of Namias.

As per claim 6, Ukita and Ryan disclose substantial features of the claimed invention as discussed above with respect to claim 1,

Ukita and Ryan are silent regarding: displaying the monetary cost associated with sending the message to the plurality of recipients (see fig. 6 and page 3, column 2, paragraph 0041).

Namias discloses a system displaying the monetary cost associated with sending the message to the plurality of recipients (see fig. 6 and page 3, column 2, paragraph 0041). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the teaching of Namias into the combined system of Ukita and Ryan such that cost associated with sending the message can be easily and efficiently displayed to the sender.

As to claim 7, Namias discloses the method of claim 6, wherein said automatically generating comprises automatically generating an updateable window displaying the monetary cost (see fig. 6, price display window 620 and page 3, paragraph 0041).

As to claim 26, Namias discloses the apparatus of claim 21, wherein the programming instructions are designed to automatically generate and display the monetary cost associated with sending the message to the plurality of recipients (see fig. 6, price display window 620 and page 3, paragraph 0041).

Art Unit: 2157

As to claim 27, Namias discloses the apparatus of claim 26, wherein the programming instructions are designed to automatically generate an updateable window displaying the monetary cost (see fig. 6, price display window 620 and page 3, paragraph 0041).

As to claim 37, Namias discloses the apparatus of claim 32, wherein the programming instruction are designed to facilitate automatic generation and displaying of the received monetary cost included within a cost window (see fig. 6, price display window 620 and page 3, paragraph 0041).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Salad E Abdullahi whose telephone number is 571-272-4009. The examiner can normally be reached on 8:30 - 5:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Abdullahi Salad
3/5/2005